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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/356,926	07/19/1999	WIM J. VAN OOIJ	19789-008	8477

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EXAMINER

LAVILLA, MICHAEL E

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 03/26/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/356,926**

Applicant(s)  
**Van Ooij et al.**

Examiner  
**LAVILLA**

Art Unit  
**1775**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jan 15, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above, claim(s) 18-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
  1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. Claims 1-16 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Poutasse et al. USP 5,622,782 for the reasons of record in the Office Action mailed on 21 May 2001.
4. Claims 1-17 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al. USP 6,071,566 for the reasons of record in the Office Action mailed on 21 May 2001.
5. Claims 1-17 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bishop USP 5,393,535 for the reasons of record in the Office Action mailed on 21 May 2001.

***Response to Amendment***

- I. In view of applicant's arguments, applicant has traversed the section 103 rejection over Poutasse of the Office Action mailed on 21 May 2001. Applicant points out that Poutasse does not exemplify using a bis-silyl aminosilane, which characterization appears to be correct. Applicant argues that applicant's showing of unexpected results should overcome the obviousness rejection. Applicant does appear to have presented evidence that use of compound A-1170, as identified in the application, results in unexpected results over the disclosure of Poutasse. However, the claimed invention encompasses compositions of much greater breadth than compositions of bis-silyl aminosilanes of the form of compound A-1170. Hence, the showings are not commensurate with the claimed invention and so the obviousness of the claimed invention is not established. Applicant argues that Poutasse has not recognized any significance with respect to the relative amounts of components. Poutasse appears to allow for variations in relative amounts that are encompassed by the claim, rendering them prima facie obvious, despite not recognizing that any particular subrange offers particular benefits. Applicant has demonstrated benefits for the limited

class of compounds evaluated. However, the claim is not commensurate in scope with this showing, rendering the rejection appropriate.

- II. In view of applicant's arguments, applicant has traversed the section 103 rejection over Brown of the Office Action mailed on 21 May 2001. Applicant traverses essentially on the same grounds as for the rejection over Poutasse. It is recognized that applicant's use of A-1170 appears to provide unexpected results, but the claimed invention is not commensurate with the showing for A-1170, and so the rejection is maintained. As for the relative amounts of components, again Brown appears to render the claimed relative amounts *prima facie* obvious, rendering the rejection appropriate
- III. In view of applicant's arguments, applicant has traversed the section 103 rejection over Bishop of the Office Action mailed on 21 May 2001. Applicant traverses essentially on the same grounds as for the rejections over Poutasse and Brown. For the same reasons as already addressed above, these arguments are not persuasive, and so the rejection is maintained.

***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
7. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael LaVilla whose telephone number is (703) 308-4428. The examiner can normally be reached on Mondays and Tuesdays.
9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (703) 308-3822. The fax phone numbers for the organization where this application or proceeding is assigned

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are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

10. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Michael LaVilla  
March 19, 2002

  
DEBORAH JONES  
SUPERVISORY PATENT EXAMINER